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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/423,501 | 11/08/1999 | JOACHIM UNGRUH | P99.1762 | 6814 |

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT PAPER NUMBER

2642

DATE MAILED: 03/26/2003

10
DUE: 6-26-03

Please find below and/or attached an Office communication concerning this application or proceeding.

AM

Office Action Summary

Application No.

09/423,501

Applicant(s)

UNGRUH ET AL.

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 6 – 15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Pat 6,031,904 (An et al.)

An et al. teach a system and method for accessing and modifying or administering a subscriber's telephony features, preferences, data, etc. via an Internet

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access unit 58 or terminal connected to an Internet server, the Internet server being connected to a telephone exchange or switch or central office, etc., and wherein that telephone exchange or switch has a profile repository 14 or database pertaining to the aforementioned features.

An et al. teach that the terminal can be connected to the Internet server 50 via either a dial-up modem through a telecommunications network (PSTN 12 for example), or through a LAN (as in a business or hotel when a subscriber is traveling for example) or some type of digital network such as ISDN lines. Furthermore, An et al. teach that the terminal could be a personal computer located at the subscriber's premises or furthermore, could just as well be a personal computer located at a service center for a service representative, i.e., human operator, to operate.

Lastly, as an alternative to the above system and method, An et al. also teach an exchange configuration wherein the web server 50 is run on one of the service manager nodes 16, connected to switch 62 so that the switch 62 realizes the features and contains the database. (Abstract, Figs. 1 – 12, Col. 1, line 32 - Col. 2, line 26, Col. 3, line 1 – Col. 5, line 34)

Inherent in the system of An et al. or any other like system is the functionality that allows html or "web-based" information such as the above features or preferences that would be modified via the web to be converted to a language that can be understood by the actual switch or database connected to the switch. There is no way for Internet communications to be directly sent to the switch and have the switch understand those communications. Therefore, the first and second claimed "switching-oriented

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applications" are either inherent or at the least obvious in An et al. because such switching applications are essential for translating or converting web-based information into a language or communication understood by the switch. Moreover, the separation of a function or device into two or more functions or devices, as well as where the claimed device or functionality is located does not make for patentability.

Moreover, see Col. 5, lines 26 – 32 and lines 56 – 59. Here, the information transmitted via the Internet is communicated to the profile repositories 18 which are either directly connected to the switch and a switch/service manager or actually located in the switch (Col. 3, lines 27 – 32) and therefore this information again, inherently must be converted into a language understood by the switch. Therefore, again, it is inherent or obvious that the system of An et al. has the claimed first and second "switching-oriented applications."

Response to Arguments

2. Applicant's arguments filed 1/7/03 have been considered but are unpersuasive.

The above rejection addresses Applicant's arguments regarding the first and second switching-oriented applications.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

H.A.A.
March 20, 2003


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
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